

**Remarks:**

Applicant hereby responds to the Office Action mailed August 2, 2004, within the shortened three month statutory period for Response. Claims 1-10 were pending in the application and the Examiner rejects claims 1-10. Upon entry of the foregoing amendments, claims 1-12 are now pending in the application. No new matter is added by these amendments. Reconsideration is respectfully requested.

Applicant thanks the Examiner for the courtesies extended during the brief conference call on August 23, 2004. This response also reflects the further explanations set forth in the voice mail to the Examiner from Applicant's attorney on August 26, 2004. Moreover, as set forth in the voice mail, Applicant's representative requests a full telephone interview for the following purpose. The Office Action mailed August 2, 2004 rejects claims 1-10 pending in the patent application. Applicant amends independent claims 1 and 6 to clarify the claimed invention. Applicant believes that a telephone interview will clarify the issue such that allowance of the application or clarification for appeal may be accomplished with only nominal further consideration. If the Examiner does not believe an allowance is warranted based on this response and amendment, **Applicant respectfully requests a telephone interview.** The Examiner is invited to telephone the undersigned at the Examiner's convenience to set up a telephone interview.

The Examiner first objects to claim 1 because of various informalities. To expedite prosecution of this matter, Applicant amends claim 1 as suggested by the Examiner.

The Examiner next rejects claims 1-10 under 35 USC 103(a) as unpatentable over Burke (6,112,191) or Barrameda (6,216,115) considered with Ray (6,018,722). Applicant respectfully traverses this rejection. Applicant asserts that Burke is limited to a system for providing excess

change during each transaction at the point of sale. To participate in the Burke system, a user must enter a special donation card or donation account number that is distinct from any form of payment account number. Significantly, the Burke reference does not disclose or suggest submitting a combined remittance in response to a periodic statement which includes previously established financial events. Moreover, as already stated by the Examiner, Burke does not disclose or suggest a hierarchy for distributing funds. As such, Burke does not disclose or suggest, for example, any one of the elements "billing said user via a periodic statement for said previously established financial events related to said user;", "accepting a combined remittance from said user in response to said periodic statement, using said charge card billing system, a portion of said combined remittance defined as funds to satisfy debts related to said previously established financial events disclosed in said periodic statement . . . ", or "applying hierarchy rules to said combined remittance to determine a portion to be allocated to said at least one investment product. . . . ", as similarly required by independent claims 1 and 6.

Applicant also adds new dependent claims 11-12 which further differentiate the presently claimed invention from the prior art because the prior art does not disclose or suggest combined remittances in response to periodic statements, wherein the periodic statements are produced as set forth in the claims.

Barrameda is limited to a very high level disclosure of small business owners using a point of sale system to invest excess funds if credits exceed debits. Significantly, Barrameda does not disclose or suggest submitting a combined remittance in response to a periodic statement which includes previously established financial events. Moreover, as already stated by the Examiner, Barrameda does not disclose or suggest a hierarchy for distributing funds. As such, Burke does not disclose or suggest, for example, any one of the elements "billing said user

via a periodic statement for said previously established financial events related to said user; ", "accepting a combined remittance from said user in response to said periodic statement, using said charge card billing system, a portion of said combined remittance defined as funds to satisfy debts related to said previously established financial events disclosed in said periodic statement . . . ", or "applying hierarchy rules to said combined remittance to determine a portion to be allocated to said at least one investment product. . . . ", as similarly required by independent claims 1 and 6.

Moreover, Ray is limited to a system whereby users actively choose investments after reviewing the results of a investment recommendations. As such, Ray does not disclose or suggest any type of hierarchy. Furthermore, the Examiner does not provide any specific motivation to combine the system of Ray with either Burke or Barrameda. As stated in MPEP 2141, "the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." (emphasis added) In order to establish a *prima facie* case of obviousness, "there must be some suggestion, teaching or motivation to modify the reference or combine the references on which the rejection is based." MPEP 2142. It is well established that "[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000). Accordingly, Office Actions rejecting claims for obviousness must be supported by evidence. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *In re Dembicza*k, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); emphasis added. Moreover,

the evidence on which an obviousness rejection is based must be set forth in the Office Action.

As stated in MPEP 2144.08 III, "Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection.... Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings."

As stated in the previous response, the novelty of the presently claimed invention is highlighted by the fact that Applicant has spent many years negotiating with the Securities and Exchange Commission (SEC) to obtain an exemptive order for the acceptance of a combined remittance with additional funds in response to a periodic statement through a charge card billing system for distribution to a brokerage account because the procedure has never been previously implemented or disclosed. **The SEC stated that the presently claimed system did not satisfy the applicable securities law requirements; however, the SEC issued a highly unusual exemptive order for the first time for strong public policy reasons.** Further, the SEC did not require the Applicant to register as a broker-dealer because the system would not send the funds to the brokerage system until after receiving the combined remittance at the billing system and dividing the funds according to the hierarchy rules. Accordingly, the prior art systems cited by the Examiner in the references **could not have previously offered a similar SEC compliant service to the presently claimed invention.**

In view of the above remarks and amendments, Applicant respectfully submits that all pending claims properly set forth that which Applicant regards as its invention and are allowable over the cited prior art. Accordingly, Applicant respectfully requests allowance of the pending claims. The Examiner is invited to telephone the undersigned at the Examiner's convenience, if

that would help further prosecution of the subject Application. Applicant authorizes and respectfully requests that any fees due be charged to Deposit Account No. 19-2814.

Respectfully submitted,

SNELL & WILMER L.L.P.

By: \_\_\_\_\_

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